

REMARKS

The following issues are outstanding in the pending application:

- Claims 1-4 and 6-21 are rejected under 35 USC 112; and
- Claims 1-4, 6-16 and 21 are rejected under 35 US 103 over Hutchins and Cook;
and
- Claims 17-19 are rejected under 35 USC 103 over Hutchins, Cook and DE Patent No. 20213719.
- Claim 20 is rejected under 35 USC 103 over Hutchins, Cook and DE Patent No. 20213719.

Claim Amendments

Claim 1, 16, and 20 are amended herein for clarity. The independent claims now distinctly specify that the cylindrical tube portion is configured to be inserted into a receiving aperture in the tub-like container such that the tub wall adjacent to the receiving aperture is located between the top surface of the base and the adjustment member. This amendment finds support throughout the specification and at least at paragraphs [0052], [0054] and Figs. 1, 3, and 4. Claim 22 is new and finds support at least at paragraph [0012] of the published application. Claim 23 is new and finds support at least at paragraph [0055] of the published application.

35 USC 112

Claims 1-4 and 6-21 are rejected by the Examiner under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicants herein have amended claims 1, 16 and 20 to remove “the bottom wall” from the claims. Additionally, the wall in the current claims is defined to be a part of the tub-like container. Applicants respectfully request withdrawal of the rejection.

35 USC 103

Claims 1-4, 6-16 and 21 are rejected by the Examiner under 25 USC 103(a) as being unpatentable over USPN 2,266,043 to Hutchins in view of USPN 2,398,921 to Cook. Applicants respectfully traverse.

Hutchins describes a portable device that is adapted to be positioned over the drain opening for controlling the flow of liquid into the drain. The device comprises a base portion, and a hollow column which is frictionally attached to the base member in a fluid-tight relation. The column has a lateral discharge opening or window adjacent to its lower end. The column may optionally have a lateral overflow opening adjacent to its upper end. The base member also has a window in the side of it which is substantially the same shape and dimension of the window in the column. The column may be rotated to bring the window of the base portion and the lower window of the column portion into alignment to make a discharge passage into the column. The size of this discharge passage may be made larger or smaller laterally to control the rate of flow by rotating the column. Hutchins teaches that having the windows positioned closely adjacent to the bottom of the sink is highly advantageous as it washes heavy particles and foreign matter out through the discharge window. The device may also function as a sink stopper by rotating the column so that the column window and base window do not overlap.

Cook describes an adjustable overflow for use in bath-tubs to safely fill the level above what is normally permitted by the usual overflow outlets. The overflow has a rotatable outside portion with openings that can be moved into and out of register with an interior wall with openings. Further openings are additionally provided on the top of the adjustable overflow to define a max level of fluid.

Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), controls the consideration and determination of obviousness under 35 U.S.C. 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734-35, 167 L. Ed. 2d 705, 715 (U.S. 2007). The four factual inquiries enunciated therein for determining obviousness are: (1) determining the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In this case, neither the level of ordinary skill in the art, nor secondary considerations are at issue. However, in order to assess the scope and content of the prior art properly, a thorough understanding of the invention must be acquired by studying Applicant's claims and the specification. M.P.E.P. § 2141. Thus, the inquiry begins with construction of Applicant's claims, explained below. Next, when ascertaining the differences between the prior art and the claims at issue, both the invention and the prior art references as a whole must be considered, and *all* claim limitations must be considered when determining patentability of Applicant's invention. M.P.E.P. §§ 2141; 2143. When this is properly done in this case, as shown below, it becomes clear that differences exist that preclude obviousness. And finally, the test for obviousness requires identification of a reasonable basis for combining the claimed elements in the claimed fashion. *KSR*, 127 S. Ct. at 1741; M.P.E.P. § 2143. As shown below, this requirement is not met in this case, and no *prima facie* case for obviousness is made.

Applying the proper test to this case begins with amended independent claims 1, 16 and 20 that require the cylindrical tube to be configured to insert into a receiving aperture in the tub-like container such that the wall adjacent to the receiving aperture is located between the top surface of the base and the adjustment member. Neither Hutchins nor Cook disclose such a feature. Both devices described by the prior art are only located within the tub itself. While Hutchins does illustrate a drawing of a sink wastepipe, Hutchins specifies that the wastepipe is a part of the conventional sink and not part of the invention. In fact, Hutchins states "[t]his invention relates to portable devices adapted to be positioned over the drain opening of a sink, or the like, for controlling the flow of the liquid into the drain" (Hutchins, page 1, col. 1, ll. 1-4).

Hutchins's portable device, therefore, is not attached to the wastepipe, as given in the currently amended claims. Even if the wastepipe and associated flange could be interpreted to be part of the invention, neither cylindrical tube of Hutchins is configured to be inserted into an aperture in the tub-like container. Neither does Cook disclose a cylindrical tube that is configured to insert into a receiving aperture. Figures 1, 3, 4 and 6 show example configurations of the claim. The wall of the tub-like container is element 2, the base member is element 8, the cylindrical tube is element 10 and the adjusting member is element 6. As shown in the figures, the wall 2 is located between the base member 8 and the adjusting member 6, while the cylindrical tube is inserted through an aperture in the wall 2.

Further, with regard to claim 4, neither Hutchins nor Cook disclose an adjustment opening that runs the full extent (from the base to the end) of the tube portion. The Examiner has only generically cited figures 1-5 of Hutchins to account for this limitation. However, each figure of figures 1-5 of Hutchins shows the opening that only runs from the base to far under the height of the tube portion. Applicants respectfully request the Examiner cite the specific element of a figure to account for this limitation.

With regard to claim 6, the Examiner cites Hutchins "8, 5" for providing different locking positions for turning the adjusting member relative to the base, and Figures 1-5. However, the Applicants cannot specifically tell what the Examiner is referring too. The instant specification describes the stop means as providing "that the adjusting member always engages on the base or the tube portion whenever a first and second adjustment opening overlaps." The Applicants can only find a stop means in Hutchins that stops the top tube from going to far into the base. Basically Hutchins discloses a vertical stop, not the horizontal adjustment stop as laid out in claim 6. Applicants respectfully request clarification if this is not the element in Hutchins the Examiner is referring too.

Regarding claim 8, the Examiner has only generally referred to Figures 1-5 of Hutchins as teaching a base having two stops to limit a turning angle. However, the Applicants cannot find any such elements in Figures 1-5 of Hutchins. Applicants respectfully request the Examiner cite the specific element the Examiner is using to account for this limitation.

Regard claim 9, none of the discharge apertures in Figures 1-5 of Hutchins show a discharge aperture in the base that is aligned transversely to the cylindrical tube. See for example Figure 6 of the instant specification, element 12. The discharge aperture 12 is transverse to the cylindrical tube portion, while in Figures 1-5 of Hutchins, any fluid discharge runs directly downward from any of the cylindrical tube portions. As such, Hutchins does not account for this limitation.

Claim 10 is also not accounted for in either cited art reference. The claim specifically recites that the overflow consists entirely or partially of a material which automatically becomes water-permeable after it has been wet for a certain time. The Examiner has cited column 1 lines 50-55 and page 1 column 2 lines 1-12 of Hutchins. However, these passages only state that the base portion is constructed of soft rubber or similar elastic, yieldable material and a hollow column 2 which may be of rugged material such as metal..." Nowhere does it specify that any such material becomes water-permeable after it has been wet for a certain amount of time.

Regarding claims 12 and 13, Hutchins does not disclose an inspection opening in the region of the base and a removable cap in said opening (see Figs. 13 and 22 of the instant specification for examples of the inspection opening and cap). The Examiner points to Figure 2 of Hutchins, elements 11 and 12, however, the element the Examiner cites as the inspection opening (11) is not sealed with a removable cap. Element 12 of Hutchins is described as a "strainer 12 of the sink" (see page 2, col. 1, ll. 12 of Hutchins). A strainer would not be able to create a seal, and neither is it located on the base of the overflow. Further, these claims specify that the base have both a discharge aperture (see claim 1) and the inspection opening (claims 12 and 13). Hutchins does not have both an inspection opening and a discharge aperture.

Regarding claim 14, the instant specification discloses means for connecting a drainage hose, such as an external and/or internal threaded portion, a hose union or a hose plug-in member (see original claim 14). The Examiner cited elements used to account for the claim limitations from Hutchins are 11 (a wastepipe) and 12 (a strainer). However, neither of these are a means for connecting a drainage hose.

Claim 15 reads that at least one adjustment opening and/or the open end of the adjusting member is/are designed in the form of a grating. The Examiner cites the strainer element 12 of Hutchins to account for this limitation, however, element 12 of Hutchins is the “strainer 12 of the sink.” This strainer is not located on an adjustment opening and/or the open end of the adjusting member, and as such, this element does not account for the full claim limitation.

Regarding claim 21, the Examiner cites the proportions of Figures 1-3, elements 29 and 31 of Cook as accounting for the limitation that “the additional adjustment opening is smaller than the first adjustment opening. However, it is improper to cite the proportions of features in a drawing that is not to scale to account for proportional claim limitations. See MPEP 2123, “proportions of features in a drawing are not evidence of actual proportions when drawings are not to scale.”

Claims 17-19 are rejected by the Examiner under 25 USC 103(a) as being unpatentable over Hutchins in view of Cook, further in view of DE Patent No. 20213719 (the “German Patent”). Applicants respectfully traverse.

Applicant respectfully submits that the previous discussion of the patentability of the current invention over the Hutchins and Cook references obviates this rejection. The German Patent reference adds no new teaching to the Hutchins and Cook references that would result in the inventive package of amended claim 16. Claims 17-19 depend at least in part on amended independent claim 16. If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of their dependency from 16, claims 7-19 are nonobvious over these references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 17-19 under 35 U.S.C. 103(a) as being unpatentable over Hutchins in view of Cook, in further view of the German Patent.

Claim 20 is rejected by the Examiner under 25 USC 103(a) as being unpatentable over Hutchins in view of Cook, further in view of the “German Patent”. Applicants respectfully traverse.

Since the German Patent is in German, the Applicants only describe the figures. The German Patent illustrates a square-like tub with an opening therein. The square like tubs may be stacked on top of each other and may have brackets coming off of the ends.

It does not appear that the German Patent illustrates any of the previously discussed features of the currently amended independent claims that were not accounted for in either Hutchins or Cook. For example, none of the references Hutchins, Cook, or the German Patent account at least for the cylindrical tube being configured to insert into an aperture of the tub-like container. As such, no *prima facie* case of obviousness has been made by the Examiner and the Applicants respectfully request withdrawal of the rejection.

Applicants assert that the correspondence of cited art elements above to the instant claim elements are the Examiner's interpretation and the Applicants do not necessarily agree with such interpretations. Any claim elements discussed as corresponding to the cited art elements in this paper are for the clarity of argument against the Examiner's interpretations.

CONCLUSION

Applicants respectfully requests reconsideration in view of this response. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P03260US0 from which the undersigned is authorized to draw.

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Respectfully submitted,

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